REMARKS

Reconsideration of the issues raised in the above referenced Office Action is respectfully solicited.

Applicants appreciate the grouping together of species A and C. Applicants further appreciate the examination of Claims 19-21 directed to the features of the prism elements. Added Claims 22-24 depend from Claims 20 and 21 and further define the features of the prism elements.

The attached Information Disclosure Statement includes documents cited in a related European Patent Application. Consideration and initialing of Form PTO-1449 is respectfully requested.

The objections to the drawings set forth on Form PTO-948 has been considered. Formal drawings are provided herewith. Further, Figures 7 and 8 are amended to label the connecting plate 19. Figures 15 and 16 have been amended to renumber the lower prisms 40 and 41 as prisms 48 and 49. This prevents a conflict with reference numerals already utilized in the application. Figures 15 and 16 are also amended to illustrate the stereoscopic width B. Approval of the drawing amendments and formal drawings is respectfully requested.

The specification has been amended to provide proper antecedent basis for a swivel axle arranged in a vertical manner as recited in Claim 7. The specification has been amended to prevent the use of reference numerals "5" and "40" for different elements. The specification is amended to define the prism elements in Figure 16 by reference numerals 48 and 49. Approval of the amendments to the specification is respectfully requested.

The rejection of Claims 4 and 13-18 under 35 USC §112, first paragraph, as failing to comply with the enablement requirement has been considered. In Claim 4, the phrase "on said microscope and movably in a guideway" has been deleted. This removes the objection to Claim 4. Claim 13 has been amended as suggested in the Office Action to overcome the rejection. In view of the above amendments, reconsideration

and withdrawal of the rejection of claims under 35 USC §112, first paragraph, is respectfully requested.

The rejection of Claims 7, 10-12 and 14-18 under 35 USC §112, second paragraph, has been considered.

Claim 7 has been amended to depend from Claim 4, which provides proper antecedent basis for the swivel axle.

Claim 10 has been amended to depend from Claim 9, which recites first and second optical devices. Therefore, there is now proper antecedent basis for the elements of Claim 10.

The rejection of Claim 11 as being indefinite by the recitation of a "Porro prism system" has been considered. Claims 11 and 12 have been cancelled and amended Claim 1 now recites a "Porro prism system of the second type". Porro prism systems are described in the art as shown by the following patents. Cited U.S. Patent No. 4 015 898 to Schirmer discloses a Porro prism at column 4, lines 1-2. Attached U.S. Patent No. 6 474 815 to Ulbers, at column 4, lines 54-58 further discloses a set of Porro prisms P of the first or second type for aligning an image. Thus, it is clear that the phrase "Porro prisms of the second type" has a definite meaning. Therefore the language of amended Claim 1 is definite.

Claim 14 has been amended to provide proper antecedent basis for the first spindle drive and the threaded spindle.

Claim 15 has been amended to provide proper antecedent basis for the intermediate image and the additional optical device. The additional optical device is now recited as a second optical device. Further, the relationship between the first guide pin and the guide pin in Claim 14 has been clarified.

For the above reasons, reconsideration and withdrawal of the rejection of Claims 7, 10-12 and 14-18 under 35 USC §112, second paragraph, as being indefinite is respectfully requested.

Applicants' appreciate the indication of allowable subject matter in Claims 9, 20 and 21. Claims 9 and 20 have

been rewritten in independent form. Therefore allowance of Claims 9 and 20, and Claims 10 and 21-24 dependent therefrom, is respectfully requested.

The rejection of Claims 1, 4-7, 13 and 19 under 35 USC §102(b) as being anticipated by Volk, U.S. Patent No. 5 526 074 has been considered. Claim 11 has been cancelled and the "Porro prism system of the second type" has been incorporated into Claim 1. Therefore, withdrawal of the rejection of Claims 1, 4-7, 13 and 19 under 35 USC §102(b) as being anticipated by Volk is respectfully requested.

The rejection of Claims 11 and 12 as being unpatentable over Volk in view of Schirmer, U.S. Patent No. 4 015 898 and Twisselmann, German Patent document no. DE 35 39 009 has been considered. Since Claim 11 has been incorporated into Claim 1 and Claim 12 has been cancelled, this rejection will be discussed with respect to Claims 1, 4-7, 13 and 19.

Volk discloses a full field reinverting indirect contract ophthalmoscope. Figure 6 shows an embodiment of the invention including contact lens device 12 placed on the cornea of a patient's eye, a separate image erecting component 16 positioned between the contact lens device 12 and a projection lens 64. The lens 64 is adjacent the lens 18 of a microscope.

The Office Action considers the contact lens device 12 of Volk to be a first optical device which creates a reverse image and the image erecting component 16" to be a second optical device. The second optical device 16" includes prisms 100, 102. The second optical device 16" can be mounted to a rod 68 attached by a ball and socket arrangement 86 to a microscope. The rod 68 can be rotated to traverse an arcuate path transverse to the optical axis of the microscope as set forth at column 6, lines 30-40. The prism system is spaced from the microscope by substantially the entire length of the rod 68.

Column 6, lines 12-18 of Volk discuss the lens 64, which has a positive optical power and is disposed adjacent the objective lens 18 of the microscope. The lens 64 reduces the

required distance between the microscope and the eye to be viewed.

Applicants' Claim 1 now recites "a Porro prism system of the second type which has a small height, and which is carried by a holder connected to the microscope so as to be moved or swung into the beam path of the microscope between the lens and the eye to be treated, wherein the Porro prism system is provided directly in front of the lens at a distance from the eye". Applicants' Figures 11-13 illustrate the Porro prism.

The feature of a Porro prism is not present in Volk. The prism illustrated in Figure 6 of Volk corresponds to the type of prism illustrated in Applicants' Figures 1 and 5, which comprises an Uppendahl prism system. Therefore, a Porro prism system is not disclosed or suggested by Volk, much less a Porro prism system of the second type.

The Office Action, however, indicates that there is no criticality to the type of prism system utilized and that any combination of prisms would be known to one of ordinary skill in the art. An Uppendahl prism system used in a microscope is disclosed by Schirmer and a Schmidtpechan prism system is disclosed by Twisselmann. The applied prior art, however, does not disclose or suggest the use of a Porro prism system, much less provide motivation to substitute a Porro prism system of the second type for the prism of Volk.

Furthermore, the Porro prism system of the second type is preferred by Applicants. The Porro prism system of the second type is extremely flat and therefore excellent for positioning below the lens of the microscope and providing a narrow spacing of the microscope from the eye to be viewed.

Applicants' Claims 4, 5, 7, 13 and 19 are allowable for the reasons set forth with respect to independent Claim 1.

Applicants' Claim 6 recites a "projection lens being directly adjacent to the lens only when the prism system has been moved or swung into the beam path of the microscope". This element is illustrated in Applicants' Figure 1 by projection lens 28 located adjacent lens 4 of the microscope.

Volk discloses the use of a lens 64 for adjusting the optical path. However, the lens 64 of Volk is not adjacent to the lens only when the prism system has been moved or swung into the beam path.

For the above reasons, Claims 1, 4-7, 13 and 19 are allowable over the combination of Volk, Schirmer and Twisselmann.

The rejection of Claims 1, 2, 8, 13, 14 and 19 under 35 USC §103 as being unpatentable over the prior art described in columns 2 and 3 and shown in Figure 1 of the patent issued to Luloh, U.S. Patent No. 5 793 524, in view of Reiner, U.S. Patent No. 5 009 487 has been considered. Independent Claim 1 now recites a Porro prism system of the second type. This feature is not disclosed or suggested in Luloh or Reiner. Therefore, withdrawal of the rejection of Claims 1-2, 8, 13, 14 and 19 is respectfully requested.

The rejection of Claims 11 and 12 under 35 USC §103 as being unpatentable over the prior art described in Luloh in view of Reiner and further in view of Schirmer and Twisselmann has been considered. As discussed above, Claim 1 includes the features of Claim 11. Therefore claim 1, and the claims dependent therefrom will be considered in view of the combination of Luloh, Reiner, Schirmer and Twisselmann.

As discussed above, Schirmer and Twisselmann do not disclose a Porro prism system. The benefits of the use of a Porro prism system of the second type have been discussed above.

The prior art system described in columns 1 and 2 and shown in Figure 1 of Luloh is an optical device for non-contact viewing of a fundus. This system includes an adapter 18 that attaches to the lower end of a microscope and replaces the conventional objective lens of the microscope. The adapter 18 includes a reduction lens 20 and an attachment 12. The attachment 12 supports a wide-angle lens 22 at a lower end. The lens 22 fits into a spring clamp 24, which extends

from a vertically movable rod 26. The rod slides within a tube 28 and is easily pushed vertically upward.

Reiner discloses a prism system for a stereoscopic microscope. The embodiment of Figure 5 illustrates a prism system 19 located between collective lenses 16 and the eye of a patient. A prism moving mechanism 35 moves the prism system 19 in a lateral direction.

The Porro prism system of Claim 1 is not disclosed or suggested by Luloh, Reiner, or the other applied prior art.

For the reasons set forth above, allowance of Claim 1, and the claims dependent therefrom, is respectfully requested.

Applicants appreciate the indication of allowable subject matter in Claims 15-18. Allowance of Claims 15-18 is respectfully requested.

Added Claims 22-24 depend from Claim 20 and therefore are allowable.

Added independent Claim 25 recites a microscope and attachment including a holder for supporting a prism system and a projection lens positioned at an opening of the prism system adjacent the microscope. The "prism system, said projection lens and said optical device are pivotable from a position in the beam path of said microscope between the microscope lens and the eye to be viewed and a position out of alignment with the beam path of said microscope". This arrangement is not provided in the applied prior art. For example, Volk discloses a projection lens 64 fixed relative to the microscope lens 18. Therefore, allowance of Claim 25, and Claim 26 dependent therefrom, is respectfully requested.

For the above reasons, allowance of Claims 1-10 and 13-26 is respectfully requested.

Further and favorable reconsideration is respectfully solicited.

Respectfully submitted,

Brian Tumm

Brian R. Tumm

BRT/ad

FLYNN, THIEL, BOUTELL & TANIS, P.C.
2026 Rambling Road
Kalamazoo, MI 49008-1631
Phone: (269) 381-1156
Fax: (269) 381-5465

Dale H. Thiel	Reg. No. 24 323
David G. Boutell	Reg. No. 25 072
Ronald J. Tanis	Reg. No. 22 724
Terryence F. Chapman	Reg. No. 32 549
Mark L. Maki	Reg. No. 36 589
David S. Goldenberg	Reg. No. 31 257
Sidney B. Williams, Jr.	Reg. No. 24 949
Liane L. Churney	Reg. No. 40 694
Brian R. Tumm	Reg. No. 36 328
Robert J. Sayfie	Reg. No. 37 714

Encl: Formal Drawings (15 sheets)
Information Disclosure Statement
Priority Document Transmittal, and Claim of Priority
Copy of U.S. Patent No. 6 474 815 B1
Postal Card

136.0703